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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,656	02/13/2002	Hubert Baumgart	IN-5554	7707
26922	7590	12/01/2004		
BASF CORPORATION ANNE GERRY SABOURIN 26701 TELEGRAPH ROAD SOUTHFIELD, MI 48034-2442				
EXAMINER				
SERGENT, RABON A				
ART UNIT		PAPER NUMBER		
1711				

DATE MAILED: 12/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/049,656

Applicant(s)

BAUMGART ET AL.

Examiner

Rabon Sergeant

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-37, 40 and 41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-37, 40 and 41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

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1. Claims 21-37, 40, and 41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The language, "positionally isomeric", when recited without specific reference to the actual isomer, renders the claims indefinite, because it is unclear what meaning or purpose is conveyed by the language. How is "positionally isomeric diethyloctanediol" different from diethyloctanediol? Applicants' response has been considered; however, the position is maintained that it is unclear if the language "positionally isomeric diethyloctanediol" without reference to locations of the isomeric features defines a different compound from diethyloctanediol. It appears from applicants' response that the hydroxyl groups are not intended to be attached to the ethyl substituents; however, it is unclear if the argued language precludes such an interpretation.

Furthermore, within claim 21, the language, "a reaction product comprising two or more repeating units derived from a positionally isomeric diethyloctanediol monomer", renders the claims indefinite, because it is unclear if the repeating units are derived from the monomer or if the reaction product simply comprises two or more repeating units and the reaction product is derived from the monomer.

2. Claims 21-37, 40, and 41 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

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Support has not been found for claiming that the "repeating units" are derived from the isomeric diethyloctanediol monomer. At page 4 of the specification, it is merely disclosed that the oligomer or polymer contains repeating units.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 21, 22, 24, 27-31, 33-37, 40, and 41 are rejected under 35 U.S.C. 102(a) as being anticipated by WO 00/15725.

The reference discloses coating compositions wherein diethyloctanediol is disclosed as a reactant. See page 15, line 10. Though the reference fails to disclose the particular isomer, the claims are considered to be met, because the claims encompass all position isomers. Applicants' argument that the reference fails to disclose at least two repeating units derived from the

monomer is not well taken. The position is taken that the use of a reactant to yield a polymer will inherently satisfy applicants' claim language, because the polymer by definition comprises repeating units derived from the monomeric reactants.

5. Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

6. Claims 21-37, 40, and 41 are rejected under 35 U.S.C. 102(b) as being anticipated by DE 19826715.

The reference discloses coating compositions derived from 2,4-diethyloctane-1,5-diol. See abstract. Despite applicants' arguments, the abstract clearly discloses the curing of a polymerizable composition comprising the compound derived from 2,4-diethyloctane-1,5-diol, and the position is taken that the resulting polymer satisfies the "repeating unit" limitation. Additionally, it remains unclear with respect to exactly what constitutes applicants' "repeating units". The limitation of claims 40 and 41 is satisfied by any repeating units, including units derived from other than diethyloctanediol.

7. Claims 21, 22, 24, 27-31, 40, and 41 are rejected under 35 U.S.C. 102(b) as being anticipated by GB 778924.

The reference discloses polymeric compounds produced from 3,6-diethyl-1,8-octanediol. See page 4, lines 55 and 75-85. Despite applicants' remarks, the skilled artisan would immediately envisage the use of the saturated diethyloctanediol within the disclosed polymers at page 4, lines 83-85. Furthermore, the position is taken in view of a polymer's definition requiring repeating units that the disclosed polymers inherently satisfy the argued "repeating

unit" language. Lastly, given the broadly claimed polydispersity range, the position is taken that the disclosed polymers inherently satisfy this limitation.

8. Claims 21-37, 40, and 41 are rejected under 35 U.S.C. 102(a) as being anticipated by EP 940459.

The reference discloses coating and adhesive compositions derived from various diethyloctanediols, including 2,4-diethyloctane-1,5-diol. See page 2 and claims. Applicants' argument that the diethyloctanediol does not react is not well taken; the argued example appears to be a two component polyurethane composition, wherein the argued diol is one of the polyhydroxyl reactants. Clarification of applicants' position is requested.

9. Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

10. Claims 21-37, 40, and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 00/15725 or DE 19826715 or GB 778924 or EP 940459.

As aforementioned, the references disclose the use of diethyloctanediol in the production of polymers, suitable for use as coatings and adhesives.

11. Though the references fail to disclose each of applicants' claimed isomers, the position is taken that it would have been obvious to utilize any isomer of diethyloctanediol in the production of polymers, based upon the teachings of the references. The basis for this position resides with the expectation that compounds that have a close structural similarity possess similar properties. *In re Wilder*, 563 F.2d 457, 195 USPQ 426 (CCPA 1977). *In re May*, 574 F.2d 1082, 197 USPQ 601 (CCPA 1978). This position is bolstered by the fact that the utility and function of the

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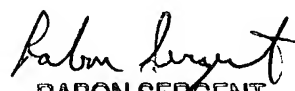
argued compounds within polymerization reactions were well understood; therefore, the skilled artisan would have had a reasonable expectation of success in substituting one compound for another.

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (571) 272-1079.

R. Sergent
November 29, 2004


RABON SERGENT
PRIMARY EXAMINER